



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/538,677 | 03/30/2000 | Stephan Meyers | 4925-39 | 8738 |

7590

02/03/2003

Michael C Stuart
Cohen Pontani Lieberman & Pavane
551 Fifth Avenue
Suite 1210
New York, NY 10176

EXAMINER

VAN DOREN, BETH

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 02/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/538,677

Applicant(s)

MEYERS, STEPHAN

Examiner

Beth Van Doren

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The following is a Final Office Action in response to communications received on 11/07/2002. Claims 1 and 6 have been amended. Claims 1-7 are now pending in this application.

Response to Amendment

2. Applicant's amendments and remarks with regards to the drawings are sufficient to overcome the drawing objections set forth in the previous office action.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomson (WO 99/35830) in view of Rosen et al. (U.S. 6,260,192).

5. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomson (WO 99/35830) and Rosen et al. (U.S. 6,260,192) in view of Gordon et al. (U.S. 6,208,335).

6. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomson (WO 99/35830) and Rosen et al. (U.S. 6,260,192) in view of Maruoka (WO 83/03181).

7. As per claim 1, Thomson teaches a portable rating apparatus for rating media content, comprising:

a user-manipulated control dedicated for generating a signal indicating a user-supplied rating of currently played media content in response to a user-supplied rating, the user-supplied rating corresponding to one of a plurality of predefined categories of preferences (See Figure 2A and 2B which disclose ratings for media content. See also page 3, lines 24-25, page 5, lines 10-25, page 6, lines 2-17, which discuss a user-manipulated control that sends a signal to a processor containing user-supplied rating information. Predefined categories of preferences are shown by the examples “I Loved” v. “I Hated”, ratings 1-5, and letters “A”-“D”);

a portable media player comprising a processor and a memory device, said processor operatively connected to said user-manipulable control for receiving the signal from said user-manipulable control and for associating the rating with the currently played media content, said memory device including a dynamically updateable ratings list for storing a list of user-supplied ratings associated with media content, said memory device operatively connected to said processor for storing the user-supplied rating associated with the currently played media content in the ratings list, wherein said processor is further operable for ranking the media content in response to the user-supplied ratings in the ratings list and selectively suggesting and playing media content based on the user-supplied ratings list (See page 5, lines 26-30, and page 6, lines 4-5, and page 10, lines 26-29, and Figure 4, which discloses a processor that interacts with the user-manipulable control and receives the rating information from said control. See page 6, lines 21-25, and figure 4, which disclose a memory device that is connected with the processor and stores rating information. The media player, which is portable because it is moveable to other locations, receives the user-supplied rating and associates it with currently played media content. The ratings are dynamic and updateable because the user can continue to supply ratings over

Art Unit: 3623

time, thus changing the rating profile of the user. The processor and memory work together to selectively determine media for the user by using the rating information in memory to rank other media content and then play the selected media content). Thomson further teaches that the device downloads media information to the player and stores this information (See pages 9-11, specifically page 8, lines 5-14, and figure 4).

However, Thomson does not expressly disclose the ability of the media player to download media content.

Rosin et al. discloses the ability of the media player to download content (See figure 1, column 2, lines 44-64, column 3, lines 1-28, and column 4, lines 25-33 and 45-65, which discloses downloading media content to the media player of the user).

Both Rosin et al. and Thomson disclose a media player that allows a user to choose media and after some time the player selectively suggests media to the user. It would have been obvious to one of ordinary skill in the art at the time of the invention for the media player of Thomson to download the media content in order to increase the speed and quality of the media delivered to the player.

8. As per claim 2, Thomson teaches a device wherein said memory device further stores media content and said processor receives the signal from said user-manipulable control as said processor plays the media content (See page 3, lines 21-23, page 8, lines 8-11 and 20-27, which discloses a memory device that stores media content. See page 4, lines 25-30, page 5, lines 1-15 and 26-29, and page 10, lines 17-19, which disclose a processor that enacts the media content stored in the memory device based on signals received from the user-manipulable control).

Art Unit: 3623

However, Thomson does not expressly disclose that the memory device stores the currently played media content or that the processor plays media that is stored in the memory device.

Rosin et al. discloses that the memory device stores the currently played media content and the processor plays media stored in the memory device (See figure 1, column 2, lines 44-64, column 3, lines 1-28, and column 4, lines 25-33 and 45-65, wherein the memory device stores the downloaded media content, which the processor proceeds to play).

Both Rosin et al. and Thomson disclose a media player that allows a user to choose media and after some time the player selectively suggests media to the user. Both Rosin et al. and Thomson also disclose that a processor interacts with a memory device in order to play the media content. It would have been obvious to one of ordinary skill in the art at the time of the invention for the memory device of Thomson to store the media content along with the substance of the media and the ratings provided by the user in order to increase the speed at which the user can access the media content once he/she chooses to view/listen to it.

9. As per claim 3, Thomson teaches a device wherein the user-manipulable control includes a switch having a plurality of depressible buttons, each of said plurality of depressible buttons corresponding to one of said predefined categories of preferences (See page 6, lines 12-20, which discusses pressing keys and entering rating information associated with predetermined categories. See also figure 4 and page 5, lines 10-23, which describe a control unit (450 R) with pressable buttons that can be used to select ratings that correspond with predefined categories).

10. As per claim 4, Thomson discloses a device wherein said user-manipulable control includes depressable buttons, each of said buttons corresponding to one of said plurality of predefined categories of preferences (See page 6, lines 12-20, which discusses pressing keys and

Art Unit: 3623

entering rating information associated with predetermined categories. See also figure 4 and page 5, lines 10-23, which describe a control unit (450 R) with pressable buttons that can be used to select ratings that correspond with predefined categories). However, Thomson does not expressly disclose that said user-manipulable control includes a multi-position switch movable among different positions, each of said positions corresponding to one of said plurality of predefined categories of preferences.

Gorden et al. discloses a user-manipulable control includes a multi-position switch movable among different positions, each of said positions corresponding to one of said plurality of predefined categories of preferences (See column 2, lines 28-31, and column 6, lines 39-49, which discloses a joystick associated with the remote control and used, with its multi-position switch, to select predefined regions).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a multi-position switch in the user-manipulable control device because said switch would increase the ease of use of the control device for the user. A multi-position switch allows a user to more easily and more rapidly navigate through and input rating information (See Gorden et al., column 2, lines 13-17). Multi-position switches are old and well known to remote controls.

11. As per claim 5, Thomson discloses a device wherein said user-manipulable control includes depressable buttons (See page 6, lines 12-20, which discusses pressing keys on the control to enter rating information. See also figure 4 and page 5, lines 10-23, which describe a control unit (450 R) with pressable buttons that can be used to select ratings). However,

Art Unit: 3623

Thomson does not expressly disclose that said user-manipulable control includes a multi-position switch with a pivotable lever.

Gorden et al. teaches a device wherein the multi-position switch includes a pivotable lever (See column 2, lines 28-31, and column 6, lines 39-49, which discloses a joystick associated with the remote control. The multi-position joystick has a pivotable lever).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a multi-position switch with a pivotable lever in the user-manipulable control device because said switch with a pivotable lever would increase the ease of use of the control device for the user. A multi-position switch allows a user to more easily and more rapidly navigate through and input rating information (See Gorden et al., column 2, lines 13-17). Multi-position switches with pivotable levers are old and well known to remote controls.

12. As per claim 6, Thomson teaches a device with a user-manipulable control which is attached to a portion of a headphone (See figure 4, which discloses a user-manipulable control and a processor and the memory device attached to the media player). However, Thomson does not expressly teach that the user-manipulable control is attachable to a portion of a headphone.

Maruoka teaches a device wherein the user-manipulable control is attachable to a portion of a headphone (See figures 1, 2, and 4 and abstract, which discloses a control unit attachable to a headphone).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate headphones into the control device because the headphones would increase the user friendliness of the apparatus by offering user privacy while rating media content.

13. As per claim 7, Thomson teaches a device with a user-manipulable control (See also page

Art Unit: 3623

3, lines 24-25, page 5, lines 10-25, page 6, lines 2-17, which discuss a user-manipulated control that sends a signal to a processor containing rating information). However, Thomson does not expressly disclose this device attachable to a portion of a headphone wherein said portion of a headphone includes a headphone cord.

Maruoka teaches a device attachable to a portion of a headphone wherein said portion of a headphone includes a headphone cord (See figures 1, 2, and 4 and abstract, which discloses a control unit attachable to a headphone and headphone cord).

It would have been obvious to one of ordinary skill in the art at the time of the invention make the user-manipulatable device attachable to a portion of a headphone wherein said portion of a headphone includes a headphone cord because doing so would increase the ease of use of the device by offering better quality sound. Using a wire over a signal decreases the chance of the signal being interrupted.

Response to Arguments

14. Applicant's arguments with regard to the teachings of Thomson (WO 99/35830) have been fully considered but they are not persuasive. In the remarks, the Applicant argues that does not teach or suggest (1) a portable media player having a processor and a memory device in which ratings input by the user are ranked by the processor and used by the portable media player to selectively download and play media content, (2) that the ratings control which program, i.e., what media, are sent to the user, and (3) that the memory device stores the media content.

15. In response to the applicant's argument that Thomson does not teach or suggest (1) a portable media player having a processor and a memory device in which ratings input by the user

Art Unit: 3623

are ranked by the processor and used by the portable media player to selectively download and play media content, the Examiner respectfully disagrees and further asserts that Thomson does teach a portable media player that contains a processor, as stated in figure 4, page 5, lines 26-30, page 6, lines 4-5, and page 10, lines 26-29, and a memory device, as shown in figure 4, and page 6, lines 21-25, in which ratings input by the user are ranked by the processor and used by the portable media player to selectively suggest and play media content, as shown by page 3, lines 24-27, page 5, lines 10-30, page 6, lines 1-5 and 18-30, page 7, lines 3-21, which discuss the processor using the rating to grade other media and then selectively suggesting media to the user and playing this media when chosen.

As to the amendment of the media player being portable, Examiner points out that (1) this feature appears to have no functional impact on the limitations of the claims and that making a device portable or moveable is not sufficient by itself to patentably distinguish over an old device unless there are new or unexpected results, *In re Lindberg*, 194 F.2d 732, 93 USPQ 23 and (2) the media player of Thomson is portable because it is moveable, such as from store to house, room to room, etc.

As to the amendment that the media content is downloaded, this limitation has been addressed in the rejections, as necessitated by amendment, set forth above. Furthermore, Thomson teaches downloading media information to the device, as stated on page 8, lines 5-14.

16. In response to the applicant's argument that Thomson does not teach or suggest (2) that the ratings control which program, i.e., what media, are sent to the user, the Examiner respectfully disagrees and further asserts that ratings input by the user are used by the processor

Art Unit: 3623

and the portable media player to selectively suggest and play media content, as shown by page 3, lines 24-27, page 5, lines 10-30, page 6, lines 1-5 and 18-30, page 7, lines 3-21, which discuss the processor using the ratings to grade other media and then selectively suggesting media to the user and playing this media when chosen.

17. In response to the applicant's argument that Thomas does not teach or suggest (3) that the memory device stores the media content, this limitation has been addressed in the new rejections, necessitated by amendment, set forth above. In the previous office action, the limitation media content was construed as media subject matter/contents, as the definition of content suggests. Thomson does teach that the device stores media content (summary and substance) of the media in the memory of the media player. The amendments received in the communications of 11/07/02 changed the limitation "media content" to "currently played media content", which now suggests that the limitation is the entirety of the media, rather than just the gist of the media, as taught by Thomson. Therefore, new rejections have been set forth above, as necessitated by amendment.

Conclusion

18. No claims allowed.

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3623

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kaplan (U.S. 5,963,916) teaches a network apparatus wherein a user has headphones and can listen to and rate played media.

Curtin (U.S. 5,986,200) teaches a music playback device.

Hsu (U.S. 6,195,692) teaches a WEBTV/network based device that downloads media and, after interaction with by a user, learns the preferences of the user.

"MICROSOFT: Cirrus and Microsoft to enable portable music devices based on Windows media Technology" (M2 Presswire) discloses portable media devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is (703) 305-3882.

The examiner can normally be reached on M-F, 8:30-5:00.

Art Unit: 3623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

ewd

bvd

January 19, 2003



TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600